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Lawson, & Persson, P.C. P. O. Box 712 Laconia, NH 03247-0712			THEIN, MARIA TERESA T	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT ANDREW BYERS JR.,
DAN PEARSON,
MARK CONNER, and
JENNIFER HAMILTON

Appeal 2010-004416
Application 09/892,800
Technology Center 3600

19 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
20 BIBHU R. MOHANTY, *Administrative Patent Judges*.
21 FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

1 STATEMENT OF THE CASE²

2 Robert Andrew Byers Jr., Dan Pearson, Mark Conner, and Jennifer
3 Hamilton (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final
4 rejection of claims 1-2, 5, 8-9, 15-16, 18-19, 21-30, 32-33, and 35-42, the
5 only claims pending in the application on appeal. We have jurisdiction over
6 the appeal pursuant to 35 U.S.C. § 6(b) (2002).

7 The Appellants invented methods of selling healthcare products via a
8 preloaded, user-specific template on the Internet. Specification 1:5-7.

9 An understanding of the invention can be derived from a reading of
10 exemplary claim 1, which is reproduced below [bracketed matter and some
11 paragraphing added].

12 1. A method for selling products over an electronic network,
13 wherein said steps of said method are performed by a seller
14 computer that electronically communicates with a buyer
15 computer via the electronic network, said method comprising
16 the steps of:

17 [1] identifying a user;

² Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed June 23, 2009) and the Examiner's Answer ("Ans.," mailed November 12, 2009), and Final Rejection ("Final Rej.," mailed August 19, 2008).

1 [2] transmitting a user specific order entry form to the buyer
2 computer, said order entry form comprising at least one user
3 specific product, a user specific price for said at least one
4 product, and a quantity entry field, wherein said user specific
5 order entry form comprises a user specific purchase history
6 form comprising all products that were purchased during a
7 specified time period, and wherein said quantity entry field is
8 the only field on said user specific order entry form in which
9 entry of data by said user is required to purchase said at least
10 one product;

11 [3] receiving a quantity of at least one product entered into
12 said quantity entry field by said user and sent from the buyer
13 computer;

14 [4] transmitting a shopping cart to the buyer computer, said
15 shopping cart comprising each of said at least one product
16 selected by the user; and

17 [5] receiving an instruction from said user to process an
18 order from the buyer computer.

19

20 The Examiner relies upon the following prior art:

Barnes	US 5,970,475	Oct. 19, 1999
Willner	US 2002/0065736 A1	May 30, 2002
Gavarini	US 7,080,070 B1	Jul. 18, 2006
Wong	US 6,343,275 B1	Jan. 29, 2002

21

22 Claims 1-2, 5, 8-9, 15-16, 18-19, 21-30, 32-33, and 35-42³ stand rejected
23 under 35 U.S.C. § 103(a) as unpatentable over Barnes and Willner.

³ The Examiner has omitted claim 8 in the statement of the rejection, however, has addressed claim 8 in the body of the rejection. Ans. 4 and 6. As such, we consider the omission of claim 8 from the statement of rejection as a mere typographical error.

1 Claims 1-2, 5, and 9 stand rejected under 35 U.S.C. § 103(a) as
2 unpatentable over Barnes and Gavarini.

3 Claim 8, 15-16, 18-19, 21-30, 32-33, and 35-42 stand rejected under 35
4 U.S.C. § 103(a) as unpatentable over Barnes, Gavarini, and Wong.

5

ISSUES

7 The issue of whether the Examiner erred in rejecting claims 1-2, 5, 8-9,
8 15-16, 18-19, 21-30, 32-33, and 35-42 under 35 U.S.C. § 103(a) as
9 unpatentable over Barnes and Willner turns on whether the Declaration of
10 Kenneth R. Taylor is sufficient to rebut the Examiner's *prima facie* case of
11 obviousness.

12 The issue of whether the Examiner erred in rejecting claims 1-2, 5, and 9
13 under 35 U.S.C. § 103(a) as unpatentable over Barnes and Gavarini turns on
14 whether the Declaration of Kenneth R. Taylor is sufficient to rebut the
15 Examiner’s *prima facie* case of obviousness.

16 The issue of whether the Examiner erred in rejecting claims 8, 15-16,
17 18-19, 21-30, 32-33, and 35-42 under 35 U.S.C. § 103(a) as unpatentable
18 over Barnes, Gavarini, and Wong turns on whether the Declaration of
19 Kenneth R. Taylor is sufficient to rebut the Examiner’s *prima facie* case of
20 obviousness.

21

FACTS PERTINENT TO THE ISSUES

2 The following enumerated Findings of Fact (FF) are believed to be
3 supported by a preponderance of the evidence.

4 Facts Related to the Prior Art

5 *Barnes*

17 *Willner*

18 02. Willner is directed to a computerized system for ordering goods
19 and/or services via an organization's internal computer network.
20 Willner ¶ 0003. Willner is concerned with providing a system that
21 minimizes human intervention. Willner ¶ 0008. Willner
22 describes an e-procurement system that allows users with
23 predetermined access codes to access product catalogs of vendors
24 and make purchases based on their access codes. Willner ¶'s
25 0010-0012. Users can set up frequently purchased item lists and

1 the system can create a list for the users based on the users'
2 history of purchases. Willner ¶ 0020.

3 *Gavarini*

4 03. Gavarini is directed to a system and method for assisting
5 customers in locating items and generating orders from a
6 merchant's electronic catalog. Gavarini 2:15-19.

7 Wong

8 04. Wong is directed to business-to-business web commerce and to
9 business automation systems. Wong 1:15-16.

10

ANALYSIS

12 *Claims 1-2, 5, 8-9, 15-16, 18-19, 21-30, 32-33, and 35-42 rejected under*
13 *35 U.S.C. § 103(a) as unpatentable over Barnes and Willner*

14 The Appellants contend that the Declaration Kenneth R. Taylor is
15 sufficient to fully rebut the Examiner’s prima facie case of obviousness and
16 place the application in condition for allowance. App. Br. 12. The
17 Appellants specifically argue that the Taylor Declaration provides evidence
18 that Barnes fails to describe specific limitations recited in the claims and that
19 a person with ordinary skill in the art would not have been motivated to
20 combine Barnes and Willner. App. Br. 14-24. The Examiner found that the
21 Taylor Declaration sets forth opinion and fails to set forth factual evidence.
22 Ans. 18-24.

23 We agree with the Examiner. The Declaration by Kenneth R. Taylor has
24 been fully considered but is not deemed to be persuasive.

1 The Board has broad discretion as to the weight to give to
2 declarations offered in the course of prosecution. See *Velander*
3 *v. Garner*, 348 F.3d 1359, 1371 (Fed. Cir.
4 2003)(“[A]ccord[ing] little weight to broad conclusory
5 statements [in expert testimony before the Board] that it
6 determined were unsupported by corroborating references [was]
7 within the discretion of the trier of fact to give each item of
8 evidence such weight as it feels appropriate.”) cf. *Ashland Oil,*
9 *Inc. v. Delta Resins & Refactories, Inc.*, 776 F.2d 281, 294
10 (Fed. Cir. 1985)(“Opinion testimony rendered by experts must
11 be given consideration, and while not controlling, generally is
12 entitled to some weight. Lack of factual support for expert
13 opinion going to factual determinations, however, may render
14 the testimony of little probative value in a validity
15 determination.” (citations omitted)). Although there is “no
16 reason why opinion evidence relating to a fact issue should not
17 be considered by an examiner,” *In re Alton*, 76 F.3d 1168, 1175
18 n.10 (Fed. Cir. 1996). The Board is entitled to weigh the
19 declarations and conclude that the lack of factual corroboration
20 warrants discounting the opinions expressed in the declarations.
21 See *Velander*, 348 F.3d at 1371; *Ashland Oil*, 776 F.2d at 294.
22 *In re American Academy of Science*, 367 F.3d 1359, 1368 (Fed. Cir. 2004).
23 Here, the Taylor Declaration sets forth the opinion that Barnes fails to
24 describe a purchase history form (Declaration ¶ 5). However, Barnes
25 describes that a user can repeat a previous purchase request. FF 01. The
26 system then pre-populates a request form including all of the items from the
27 previous request. FF 01. The repeat request provides a list of all of the
28 items purchased during the last purchase, which is a specified time.
29 Although the Declaration states that this is not a specified time period
30 (Declaration ¶ 5), the claims do not narrow the scope of a specified time
31 period, or how it is specified, and as such Barnes’ requisition is within the
32 scope of this broadly recited feature.

1 The Declaration also states that a person with ordinary skill in the art
2 would not be motivated to modify Barnes or combine Barnes and Willner
3 (Declaration ¶'s 6-7) and Willner teaches away from a user specific order
4 entry form (Declaration ¶ 8). However, Barnes and Willner are both
5 concerned with procurement systems that facilitate a user's ability to
6 purchase products. FF 01-02.

7 Barnes describes a system that allows a user to repeat requisition
8 requests, where the requisition request form is populated with the items
9 associated with a previous purchase. FF 01. Willner also solves this
10 problem by describing a system that allows users to create frequently
11 purchased item lists or the system creates frequently purchased items lists
12 based on users' shopping history. FF 02. A person with ordinary skill in the
13 art would have found it obvious to combine Barnes and Willner and such a
14 combination would have predictable results since both references are
15 concerned with the solving the same problem and describe similar systems.

16 Although the Declaration states that Willner teaches away from the
17 claimed user specific order entry because Willner does not provide a means
18 for the user to view prior purchases (Declaration ¶ 8), Willner does describe
19 that a frequently purchased item list can be created and viewed by a user.
20 FF 02.

21 Although Mr. Taylor states that his opinion is based on facts
22 (Declaration ¶'s 5-8), the conclusory statements in the Declaration are
23 merely factual representations of his opinion. The Appellants fail to provide
24 any further evidence or rationale pointing to where these statements are
25 supported by facts. After evaluating and weighing all of the evidence, the

1 Declaration is considered to be insufficient to rebut the Examiner's *prima
2 facie* case of obviousness.

3 The Appellants also contend that the Taylor Declaration provides
4 evidence that the Appellants identified and solved a problem that had gone
5 unrecognized prior to their invention. App. Br. 14. We disagree with the
6 Appellants. The Appellants only provide a statement in the Taylor
7 Declaration that Mr. Taylor believes that the Appellants have solved a long
8 felt need in the art. Declaration ¶ 9. There is no factual evidence to support
9 this conclusion. The Appellants further fail to provide a nexus between any
10 factual evidence of a long felt need and the claims.

11 There must be a demonstrated "nexus" between the merits of the claimed
12 invention and the evidence of secondary considerations before that evidence
13 is accorded substantial weight in an obviousness determination. *Simmons*
14 *Fastener Corp. v. Illinois Tool Works, Inc.*, 739 F.2d 1573, 1575 (Fed. Cir.
15 1984), cert. denied 471 U.S. 1065 (1985); *Stratoflex, Inc. v. Aeroquip*
16 *Corp.*, 713 F.2d 1530, 1539 (Fed. Cir. 1983); see also *In re Huang*, 100 F.3d
17 135, 140 (Fed. Cir. 1996); *In re Fielder*, 471 F.2d 640, 646 (CCPA 1973).
18 "Nexus" is a legally and factually sufficient connection between the
19 objective evidence and the claimed invention, such that the objective
20 evidence should be considered in determining nonobviousness. *Demaco*
21 *Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir.
22 1988). In the absence of an established nexus with the claimed invention,
23 secondary consideration factors such as commercial success, satisfaction of
24 a long-felt but unresolved need, licensing and copying by others are not
25 entitled to much, if any, weight and generally have no bearing on the legal

1 issue of obviousness. See *In re Vamco Mach. & Tool, Inc.*, 752 F.2d 1564,
2 1577 (Fed. Cir. 1985).

3 After evaluating and weighing all of the evidence relied upon by the
4 Examiner and provided by the Appellants, we find that the Appellants'
5 evidence is insufficient to rebut the Examiner's *prima facie* case of
6 obviousness.

7 The Appellants further contend that none of the cited references describe
8 a user specific purchase history form comprising all products that were
9 purchased during a specified time period, or provides any suggestion to
10 modify the Barnes reference to include such a feature. App. Br. 22. We
11 disagree with the Appellants.

12 This argument is nothing more than a general allegation that those
13 limitations are not described by the prior art. "It is not the function of this
14 court to examine the claims in greater detail than argued by an appellant,
15 looking for nonobvious distinctions over the prior art." *In re Baxter*
16 *Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991). *See also In re*
17 *Wiseman*, 596 F.2d 1019, 1022 (CCPA 1979) (arguments must first be
18 presented to the board). A general allegation that the art does not teach any
19 of the claim limitations is no more than merely pointing out the claim
20 limitations. A statement which merely points out what a claim recites will
21 not be considered an argument for separate patentability of the claim. 37
22 C.F.R. § 41.37(c)(1)(vii).

23

24 *Claims 1-2, 5, and 9 rejected under 35 U.S.C. § 103(a) as unpatentable*
25 *over Barnes and Gavarini*

1 The Appellants contend that these claims are allowable for the same
2 reasons discussed *supra*. We disagree with the Appellants. The Appellants'
3 arguments were not found to be persuasive *supra* and are not found to be
4 persuasive here for the same reasons.

5

6 *Claim 8, 15-16, 18-19, 21-30, 32-33, and 35-42 rejected under 35 U.S.C.*
7 *§ 103(a) as unpatentable over Barnes, Gavarini, and Wong*

8 The Appellants contend that these claims are allowable for the same
9 reasons discussed *supra*. We disagree with the Appellants. The Appellants'
10 arguments were not found to be persuasive *supra* and are not found to be
11 persuasive here for the same reasons.

12

CONCLUSIONS OF LAW

14 The Examiner did not err in rejecting claims 1-2, 5, 8-9, 15-16, 18-19,
15 21-30, 32-33, and 35-42 under 35 U.S.C. § 103(a) as unpatentable over
16 Barnes and Willner.

17 The Examiner did not err in rejecting claims 1-2, 5, and 9 under 35
18 U.S.C. § 103(a) as unpatentable over Barnes and Gavarini.

19 The Examiner did not err in rejecting claims 8, 15-16, 18-19, 21-30, 32-
20 33, and 35-42 under 35 U.S.C. § 103(a) as unpatentable over Barnes,
21 Gavarini, and Wong.

22

1

DECISION

2

To summarize, our decision is as follows.

3

- The rejection of claims 1-2, 5, 8-9, 15-16, 18-19, 21-30, 32-33, and 35-42 under 35 U.S.C. § 103(a) as unpatentable over Barnes and Willner is sustained.
- The rejection of claims 1-2, 5, and 9 under 35 U.S.C. § 103(a) as unpatentable over Barnes and Gavarini is sustained.
- The rejection of claims 8, 15-16, 18-19, 21-30, 32-33, and 35-42 under 35 U.S.C. § 103(a) as unpatentable over Barnes, Gavarini, and Wong is sustained.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

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AFFIRMED

Appeal 2010-004416
Application 09/892,800

1 mev

2

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